UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,894	09/22/2003	Nathalie Jager-Lezer	230257US0	6801

22850 7590 07/03/2007

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
VENKAT, JYOTHSNA A	
ART UNIT	**PAPER NUMBER**
1615	

NOTIFICATION DATE	DELIVERY MODE
07/03/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/664,894	JAGER-LEZER, NATHALIE	
	Examiner	Art Unit	
	JYOTHSNA A. VENKAT Ph. D	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *43-81* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *43-50 and 57-81* is/are rejected.

7)☒ Claim(s) *51-56* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of election filed on 2/5/07. Restriction between the species is withdrawn since there is no art with respect to elected species. Claims 43-81 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 79-80 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: " providing lenghthening of the eyelashes.

Claims recite " method" and these claims are incomplete and the claims lack clarity.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 43-50, 57-60, 62-63 and 65-81 are rejected under 35 U.S.C. 102(e) as being anticipated by 6,491,931('931)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The filing date of the instant application is 9/22/03 since the provisional application is in French.

See examples for polyamide fibers, film forming polymer, wax, Cyclopentasiloxane. Wax or Cyclopentasiloxane can be the fatty phase. See pigments, which read on the claimed dyestuff. Water reads on hydrophilic medium.

See col.2, lines 5-15 for fibers having length and circle of diameter. The rages claimed are within the ranges disclosed in the patent. See col.2, lines 22- 35 for various fibers, which includes claimed polyamide fibers, polyurethane fibers, polyolefin fibers, acrylic polymers. Acetate fibers or, cotton fibers, or rayon fibers read on claimed non-aromatic polyamide fiber. The *length and circle of diameter of fiber ranges claimed are within the ranges disclosed in the patent* and Patent office is not equipped to measure the limitation of claims 44-45 and therefore patent also anticipates claims 44-45, absence of evidence to the contrary.

See col.2, lines 36-45 for fibers coated, see col.5, lines 61-65 for water and the concentration of the water, see col.5, last two lines through col.6 and col.7, lines 1-148 for liphophilic medium or and fatty phase and volatile oil. See col.5, lines 1-43 for wax, see col.3, lines 5 through col.4, lines 28 for the film forming polymer, see col.8, lines 9-31 for colorant or dye stuff and see the paragraph bridging col.s 8-9 for additives. See example 3, lines 30-33 for claimed method, which is " lenghthening of the eyelashes". With respect to limitation claimed in claim 81, which is " provides lenghthening of the eyelashes that is exactly in line with them",

this is inherent since all the claimed limitations are met by the patent including lengthening of the eyelashes and therefore this property in inherent absence of evidence to the contrary.

Claims 43, 59-63, 65, 69-81 are rejected under 35 U.S.C. 102(e) as being anticipated by 6,726,917 ('917).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The filing date of the instant application is 9/22/03 since the provisional application is in French.

See col.3, line 15 for polyamide fibers, see col.1, lines 38-for for oil, which reads on claimed fatty phase, see col.2, lines 10-68 for film forming polymer, see col.3, lines 10-48 for pigments, dyestuff and see example 2 for waxes and mixture of ethanol and water, which reads on claimed limitation of claims 60-62. Examples 1-2 have additives like surfacatant, preservatives. See abstract for lenghthening of the eyelashes. With respect to limitation claimed in claim 81, which is " provides lenghthening of the eyelashes that is exactly in line with them", this is inherent since all the claimed limitations are met by the patent including lengthening of the eyelashes and therefore this property in inherent absence of evidence to the contrary.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 43-50, and 57-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents '931 and 5,911,974 ('974).

Patent '931 as explained above. Patent '931 does not teach the limitation of claim 64, whcih is anhydrous compositions. However, patent ''974 teaches cosmetic compostions and under example 2 teaches mascara composition without water. This composition is anhydrous composition and it has pigments, waxes. See col.5, lines 30-60, wherein patent teaches film former and also volatile solvent.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the compostions of '931 by not using water since patent '974

teaches in the same mascara art compostions without water. This is prima facie case of obviousness.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-50, 59-63,65, 69-80 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7-21, 26-37, 41-56, 61-67, 70 and 72 of U.S. Patent No. 6,491,931. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap with the claimed fibers in the instant application. Patent and instant application is claiming the same film forming polymer (polyurethane) and wax. Patent and instant application is also claming water, volatile oil and non-volatile oil. Patent and instant application is also claiming for fibers, fibers length and circle of diameter. The fibers are same and there is overlap with the fiber length and circle of diameter

and therefore claim 2 is also rejected since claim 2 is inherent feature of the fiber claimed in the patent.

Claims 43-50, 59-63, 65, 69-80 are directed to an invention not patentably distinct from claims 1, 7-21, 26-37, 41-56, 61-67, 70 and 72 of commonly assigned 6,491,931. Specifically, for the reasons sated above under obviousness-type double patenting rejection.

The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,491,931, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Claims 43, 59-63, 65, 69-80 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 17-23, 27-33, 43-48 of U.S. Patent No. 6,276,917. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of patent anticipates claimed fibers and there is overlap with the

claimed fibers in the instant application and claim 17 of patent. Patent and instant application is claiming the same film forming polymer (vinyl polymers, acetate polymers, claims 2and 28 of patent) and wax. Patent and instant application is also claming water, and non-volatile oil. Patent and instant application is also claiming for fibers, fiber length. The fibers are same and there is overlap with the fiber length and therefore claim 2 of instant application is also rejected since claim 2 is inherent feature of the fiber claimed in the patent.

Claims 43, 59-63, 65, 69-80 are directed to an invention not patentably distinct from claims 1-2, 17-23, 27-33, 43-48 of commonly assigned U.S. Patent No. 6,276,917. Specifically, for the reasons stated above under obviousness-type double patenting rejection.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,726,917, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Allowable Subject Matter

Claims 51-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicanst are requested to provide the examiner co-pending applications claiming polyamide-imide fibers.

The prior art cited in the specification is pertinent prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615

***